Remarks

I. Introduction

This is in response to the Office Action dated October 22, 2004. The Office Action rejected claims 11 and 12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 was provisionally rejected under the judicially created doctrine of obvious-type double patenting. Claims 1-11, 13-18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,396,842 to Aggarwal et al ("Aggarwal") in view of U.S. Patent No. 6,396,842 to Rochberger ("Rochberger"). Claims 12 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,343,320 to Fairchild et al. ("Fairchild") in view of Rochberger, further in view of U.S. Patent No. 6,192,417 to Block et al. ("Block").

In response to the §112 rejection, applicants have amended claims 11 and 12. Applicants traverse the rejection under §103. Claims 1-20 remain for consideration.

II. Previous Amendment

As an initial matter, applicants note that the Examiner indicates in paragraph 1 of the Office Action that the present Action is responsive to an amendment filed on August 4, 2004. However, no such amendment was filed on that date. The only previous amendment in this case was dated June 14, 2004. While subsequent Information Disclosure Statements have been filed, none of these have been filed on August 4, 2004. Therefore, Applicants will treat the present Office Action as being responsive to the June 14, 2004 amendment in the present application.

III. Typographical Errors

Applicants have amended claims 6, 7 and 10 to correct typographical errors in those claims. Specifically, claims 6 and 7 were originally intended to be dependent upon independent claim 5 and claim 10 was originally intended to be dependent upon claim 9. These dependencies have been corrected by amendment to those respective claims.

IV. §112 Rejection

Claims 11 and 12 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the Office Action rejected claims 11 and 12 stating that it was unclear whether the phrase "the at least one IP address" in those claims referred to the phrase "a plurality of client IP addresses" in claim 8. The Office Action further rejected claim 12 stating that the phrase "wherein at least one IP address is a server address" was unclear since claim 8 was limited to "client IP addresses. Finally, the Office Action also rejected claim 12 stating that the term "the cluster" lacked proper antecedent basis.

In response to these rejections, applicants have amended claims 8, 11 and 12. Claim 8 has been amended to replace the phrase "client IP addresses" with the phrase "IP addresses." The same phrase was amended in claim 9 in order to conform to the amendment of claim 8. Claims 11 and 12 were amended to replace the phrase "the at least one IP address" with the phrase "at least one address in said plurality of IP addresses." Claim 12 has also been amended to delete the phrase "wherein the cluster is a server cluster."

Having amended the claims, Applicants believe that all claims comply with §112. Withdrawal of all §112 rejections is respectfully requested.

V. Double Patenting Rejection

Claim 5 was provisionally rejected under the judicially created doctrine of obvious-type double patenting. Specifically, the Office Action stated that Claim 5 was obvious over claim 2 of copending U.S. Patent Application No. 09/705,325.

In response to this rejection, applicants are hereby filing a terminal disclaimer to disclaim the terminal part of the statutory term of any patent granted on the present application which would extend beyond the expiration date of the full statutory term of any patent granted on the aforementioned copending application.

Withdrawal of the provisional obviousness-type double patenting rejection is respectfully requested.

VI. §103 Rejection

Claims 1-11, 13-18 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Aggarwal in view of Rochberger. Claims 12 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fairchild and Rochberger further in view of Block. Applicants traverse the rejections under §103.

Applicants note that the §103 rejections presented in the present Office Action are substantially the same as the rejections presented in the Office Action dated January 21, 2004, except that two different references (Aggarwal and Fairchild) were relied upon in place of one of the previously-cited references (Altschuler et al.). While these two new references do contain different teachings as compared to the Altschuler reference, the Office Action has failed to respond to several arguments presented in the June 14, 2004 response filed in the present application. For reasons similar to the reasons cited in the June 14, 2004 response and for additional reasons discussed below, the rejections in the present Office Action fail to render the claims of the present application obvious.

In order for an invention to be obvious under 35 U.S.C. §103(a), there must be some suggestion to combine or modify cited prior art references in a manner which would show or suggest all elements of the claimed invention. For the same reasons as were presented in the June 14, 2004 response in the present application, the Office Action fails to show that Aggarwal in view of Rochberger teach all elements of claims 1-11, 13-18 and 20 and that those references further in view of Block teach all elements of claims 12 and 19.

Independent claims 1, 5, 8 and 17 are directed to an on-line method of classifying IP addresses into related clusters within a distributed information network. The Office Action admits that Aggarwal does not disclose the claimed limitation of "processing the plurality of IP addresses according to a radix encoded trie classification process". The Office Action relies on Rochberger to supply the missing disclosure. In order for a combination of references to be proper in support of a §103 rejection, there must be some teaching or suggestion within at least one of the references to combine the references. While Rochberger mentions a radix search tree, there is no motivation to combine Aggarwal with Rochberger such that classifications of IP addresses could be made

utilizing a radix encoded trie classification process. Such a combination is based on hindsight and is therefore improper. The Federal Circuit case law makes clear that the best defense against an improper hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). There is no such teaching or motivation to combine in the Rochberger or Altschuler et al., and therefore such a combination is improper. If the Office persists in the rejection of claims 1, 5, 8 and 17 for the stated reasons, Applicants respectfully request that the Office point out with particularity where the teaching or suggestion to combine Aggarwal or Rochberger is located within either of those references.

For the above reason, claims 1, 5, 8 and 17 are allowable over the cited art and, therefore, these claims are allowable over the cited art. Allowance of all independent claims is requested.

Claims 2-4, 6-7, 9-16 and 18-20 are dependent upon an allowable independent claim and are therefore also allowable. Claims 6, 13-16 and 20 are also allowable because they add additional allowable subject matter as follows.

Dependent claim 6 contains the limitation that "client IP addresses are extracted in real time from a network server". The Office Action cites Fairchild column 23, lines 30-36 and column 11, lines 20-30; col. 8, lines 13-31 as disclosing this "real time" limitation. However, the cited section does not disclose the real time extraction of client IP addresses. Instead, column 11 in that reference simply teaches how IP addresses of network participating devices (NPDs) can be organized into groups according to particular subnets in which those NPDs participate. The cited passage in particular merely teaches an embodiment of assigning different NPDs to such groups. Column 23, lines 30-36 teaches how a management server can accomplish "initial" discovery operations such as IP pinging to identify one or more NPDs of one or more subnets to manage. Neither of these passages teaches the necessary element of claim 6 of "wherein the IP addresses are extracted in real time from a network server." Therefore, claim 6 is allowable over the cited art.

Dependent claims 13 – 16 and 20 add limitations relating to further details of the retrie, retrie levels, and radix encoded trie. The Office Action fails to address these

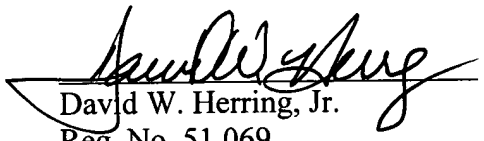
limitations, and therefore the Office Action has failed to show prima facie obviousness. The withdrawal of the rejections of these claims is therefore requested. The Office Action states that these claims are rejected for the same reasons as claims 5 and 8. However, claims 5 and 8 do not contain the limitations in these claims.

If the Examiner persists in the rejection of these claims, Applicants respectfully request that the Examiner specifically address these claim limitations.

VII. Conclusion

As discussed above, while the present Office Action has rejected the claims over newly cited art, the Office has failed to address several primary arguments presented by Applicants in the June 14, 2004 response to the January 21, 2004 Office Action. For the reasons discussed above and in the prior response, the cited art does not teach all elements of the claims as currently pending. Additionally, the combination of references relied upon by the Office is improper. As a result, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,



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